

**REMARKS-General**

1. Upon review of the original specification and in light of the observation of the Examiner noted in the above Office Action, the applicant has amended the specification which is deemed to more clearly and distinctly describe the subject matter of the instant invention, and which provides full antecedent basis to the newly drafted claims. No new matter has been included in the specification.

2. The specification has been amended in order to correct the typo error in page 6, line 1, as well as the informalities noted by the Examiner, and to more clearly describe the subject matter of the instant invention. The applicant respectfully corrects the reference character "302" which is used to designate the light enhancing chamber in page 6, line 1 of the specification.

3. The newly drafted independent claim 21 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 21-37 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

**Regarding to Rejection of Claims 1-2 under 35USC102**

4. Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

5. In view of 35 U.S.C. 102(b), it is apparent that a person shall not be entitled to a patent when his or her invention was patent in this country more than one year prior to the date of the application for patent in the United States.

6. However, the McCarthy patent and the instant invention are not the same invention according to the fact that the independent claims 1, 12 and 20 of the McCarthy patent does not read upon the instant invention and the independent claim 21 of the instant invention does not read upon the McCarthy patent too. Apparently, the instant invention, which discloses a ceiling fixture with illumination and decoration

features, should not be the same invention as the McCarthy patent which discloses a multi-configured lighting fixture for surface mounting.

7. Accordingly, McCarthy fails to anticipate the following distinctive features:

(i) a light dispersing housing defining a main light chamber therewith, wherein the light source is disposed within the main light chamber (as claimed in claim 21),

(ii) a light enhancing frame having a surrounding wall coaxially and outwardly extended from the light dispersing housing to the ceiling supporting frame, wherein the light enhancing frame has **a light enhancing chamber** which is formed within the surrounding wall and the ceiling supporting frame and is coaxially positioned above the main light chamber and **at least a light enhancing window** communicating the light enhancing chamber with an exterior of the light enhancing frame (as claimed in claim 21), and

(iii) wherein when the light source is operated, a portion of the light directly projects to the light dispersing housing within the main light chamber for illumination and a portion of the light **radially and upwardly diffuses** towards the light enhancing chamber such that a light intensity within the main light chamber is higher than a light intensity within the light enhancing chamber for providing an added light effect of the ceiling fixture at the light enhancing window (as claimed in claim 21).

8. McCarthy merely anticipates a lighting fixture a lens base 60, a illuminating lamp 180 in the fixture 20, and a lens means 144 for controlling and distributing light developed in and emanating from the light fixture without any mention of any light enhancing window communicating the light enhancing chamber for providing an added light effect at the light enhancing window when a portion of light from the light source **radially and upwardly diffuses** towards the light enhancing chamber. McCarthy merely suggests the illuminating lamp 180 produces light towards the lens means 144 for illumination. In other words, McCarthy does not disclose any light accumulated within the lens base 60 and how the light diffuses to the lens base 60 through the light enhancing window for providing an added light effect of the light fixture for decoration.

9. Throughout the entire specification and drawings, McCarthy teaches that the lens base 60 is arranged for securing the lens means 144 but not for accumulating light within the lens base 60 to allow the light passing therethrough. The applicant respectfully submits that the lens base 60 is not equivalent to the light enhancing frame of the instant invention which has a light enhancing chamber positioned above the main light chamber and a light enhancing window communicating the light enhancing chamber with an exterior of the light enhancing frame. It is apparent that McCarthy fails to teach and anticipate the same recitation and limitation in the claim 21 of the instant invention of using a single light source disposed in the main light chamber such that by creating different light intensities between the main light chamber and the light enhancing chamber, the light enhancing window provides an added light effect for the light fixture.

#### **Response to Rejection of Claims 3-20 under 35USC103**

10. The Examiner rejected claims 3-20 over McCarthy in view of Tsuji et al, Evans, Jr. et al., and Jaffari et al. Pursuant to 35 U.S.C. 103:

“(a) A patent may not be obtained thought the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

11. In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

12. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and McCarthy which is qualified as prior art of the

instant invention under 35USC102(b) are obvious in view of Tsuji, Evans, Jr. and Jaffari at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

13. However, as recited above, McCarthy merely discloses a lighting fixture a lens base 60, a illuminating lamp 180 in the fixture 20, and a lens means 144 for controlling and distributing light developed in and emanating from the light fixture without any mention of any light enhancing window communicating the light enhancing chamber for providing an added light effect at the light enhancing window. In addition, McCarthy merely teaches the baseplate having an integral ballast heat sink without any mention of any a bottom light reflective surface of the ceiling panel for substantially reflecting the light from the light source towards the light enhancing chamber.

14. Therefore, the difference between McCarthy and the instant invention as claimed in claims 21 to 37 is not limited to the disclosure of "light fixture", but includes the above distinctive features (i) to (iii). In addition, regarding to claims 22 to 37, the instant invention further contains the following distinctive features:

(iv) the light enhancing window forming a through groove formed on the surrounding wall of the light enhancing frame for communicating the light enhancing chamber with the exterior of the light enhancing frame such that when the portion of light diffuses to the light enhancing chamber, the portion of light dispenses to the exterior of the light casing through the through groove (as claimed in claim 22);

(v) a light softening layer provided on an inner side of the surrounding wall of the light enhancing frame to cover the light enhancing window for softening the portion of light dispersing therethrough (as claimed in claim 23);

(vi) the light enhancing frame has an upper surrounding edge coaxially extended from the ceiling supporting frame and a lower surrounding edge coaxially coupling with the light dispersing housing, wherein the light enhancing frame has a diameter gradually reducing from the upper surrounding edge to the lower surrounding edge such that the surrounding wall of the light enhancing frame is inclinedly and outwardly extended from the light dispersing housing to the ceiling supporting frame to form the light enhancing chamber (as claimed in claims 24 to 26 and 34);

(vii) the lower surrounding edge of the light enhancing frame forms a retaining rim substantially biasing against a circumferential edge of the light dispensing housing, wherein the retaining rim of the light enhancing frame is coaxially and inwardly extended between the main light chamber and the light enhancing chamber for controlling the light passing from the main light chamber towards the light enhancing chamber (as claimed in claims 27 to 29);

(viii) the ceiling supporting frame comprises a ceiling panel supporting the light source thereunder for securely mounting on the ceiling, and a heat insulating layer provided on the ceiling panel for blocking heat from the light source towards the ceiling, wherein the ceiling panel has a bottom light reflective surface for substantially reflecting the light from the light source towards the light enhancing chamber (as claimed in claims 30 to 32 and 36 to 37); and

(ix) the light enhancing window is a light gap formed between an upper surrounding edge of the light enhancing frame and the ceiling supporting frame for communicating the light enhancing chamber with the exterior of the light enhancing frame such that when the portion of light diffuses to the light enhancing chamber, the portion of light dispenses to the exterior of the light casing through the light gap (as claimed in claim 33).

15. Accordingly, Tsuji teaches a ceiling fan with a light assembly comprising an upper and lower housing 18, 17 to receive an upper and lower light assemblies 21, 16 respectively. In addition, Tsuji, in column 2, lines 35-45, teaches a translucent window 27 is mounted within each opening 26 of the upper housing 18 wherein the windows 27 are positioned between the upper light assembly 21 and the peripheral side wall 23 of the lower housing so that light 1 radiating from the upper light assembly 21 may be reflected off the inner liner indirectly back through the opening 26 or upwardly towards the ceiling C. In other words, Tsuji merely teaches the ceiling fan requiring a particular light assembly (upper light assembly) to illuminate the windows without any mention of any light diffusion from the light source towards the light enhancing windows within the light enhancing chamber.

16. Evans, Jr. merely teaches a high intensity indirect lighting fixture comprising and an outer translucent member and an inner light directing member with greater light

intensity than the outer translucent member without any mention of any inclined surrounding wall and retaining rim of the light enhancing frame which allows a portion of the light radially and upwardly diffuses towards the light enhancing chamber such that a light intensity within the main light chamber is higher than a light intensity within the light enhancing chamber for providing an added light effect of the ceiling fixture at the light enhancing window.

17. Jaffari, on the other hand, merely teaches a luminaire comprising a housing having an open section 40 and a transparent or translucent housing section 45 provided to close the opening 40, wherein light 44 directed upwardly from the arc tube 20 can then pass through the transparent (or translucent) section 45 to provide for up-lighting as well as side lighting, in column 3, lines 33-44. However, Jaffari fails to teach a light gap formed between an upper surrounding edge of the light enhancing frame and the ceiling supporting frame such that when the portion of light diffuses to the light enhancing chamber, the portion of light dispenses to the exterior of the light casing through the light gap.

18. The applicant respectfully submits that the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. *See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

19. In the present case, there is no such suggestion. In any case, even combining McCarthy Tsuji, Evans, Jr. and Jaffari would not suggest the above distinctive features (i) to (ix) as claimed in the instant invention and would not provide the invention as claimed in the newly drafted claims 21 to 37.

20. Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

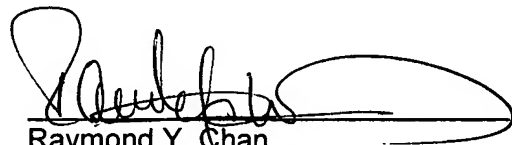
### **The Cited but Non-Applied References**

21. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

22. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 21-37 at an early date is solicited.

23. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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### **CERTIFICATE OF MAILING**

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: March 17, 2005

Signature:   
Person Signing: Raymond Y. Chan